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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,432	03/12/2004	Muhammad Chishti	018563-000550US	6231
46718	7590	06/07/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP (018563) TWO EMBARCADERO CENTER, EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				MANAHAN, TODD E
ART UNIT		PAPER NUMBER		
3732				

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/799,432	CHISHTI ET AL.	
	Examiner Todd E. Manahan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/10/04.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 10 September 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because applicant did not provide a legible copy of all non-U.S. patents. The images on the CD-ROM are of such poor quality as to render them unreadable. Furthermore, the CD-ROM submission does not comply with 37 CFR 1.52(E) because the files are not in ASCII format and it does not contain proper subject matter for CD-ROM submission (see 37 CFR 1.52). It has been placed in the application file, but the non-U.S. documents referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Priority

The domestic priority information appears to be inconsistent with USPTO record. U.S. Serial no. 10/139,153 should state that it is a CIP of PCT/US01/13280, which is a continuation of U.S. Serial no. 09/616,222. Also applicant should provide the current status of all parent applications recited in the specification.

Specification

The abstract of the disclosure is objected to because it does not provide a concise statement of the claimed invention, i.e. the polymeric shell with embedded wire. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The use of the trademarks NITINOL, BIMETAL, and MEMOTAL has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The embodiments wherein: the plastic portion comprises a first outer

section that covers the entire surface of the patient's teeth from approximately the left molars to the left canines, a second outer section that covers the entire surface of the patient's teeth from approximately the right molars to the right canines, and a middle span that covers only the labial side of the patient's teeth approximately between the canines, whereby the middle span acts as a guide for the force of the wire upon the patient's teeth; the plastic portion further comprises a first outer section that covers the entire surface of the patient's teeth from approximately the left molars to the left canines, and a second outer section that covers the entire surface of the patient's teeth from approximately the right molars to the right canines, whereby the plastic portion does not touch the patient's teeth approximately between the patient's canines; and a plurality of vertically parallel wires is imbedded within the lingual side of the plastic portion must be set forth in the specification and adequately disclosed or these features canceled from the claims. No new matter may be added.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiments wherein: the plastic portion comprises a first outer section that covers the entire surface of the patient's teeth from approximately the left molars to the left canines, a second outer section that covers the entire surface of the patient's teeth from approximately the right molars to the right canines, and a middle span that covers only the labial side of the patient's teeth approximately between the canines, whereby the middle span acts as a guide for the force of the wire upon the patient's teeth; the plastic portion further comprises a first outer section that covers the entire surface of the patient's teeth from approximately the left molars to the left canines, and a second outer

section that covers the entire surface of the patient's teeth from approximately the right molars to the right canines, whereby the plastic portion does not touch the patient's teeth approximately between the patient's canines; and a plurality of vertically parallel wires is imbedded within the lingual side of the plastic portion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bergersen (United States Patent No. 4,330,272).

Bergersen discloses a dental appliance comprising a polymeric shell 54 in the shape of an arch having cavities shaped to receive and reposition teeth from a first orientation to a successive orientation and a wire 48 mounted on the polymeric shell to span at least a portion of the arch of the polymeric shell.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Martz (United States Patent No. 4,793,803).

Martz discloses a dental appliance comprising a polymeric shell 39c in the shape of an arch having cavities shaped to receive and reposition teeth from a first orientation to a successive orientation and a wire 56 embedded in the polymeric shell to span at least a portion of the arch of the polymeric shell (see figure 10).

Claims 1, 2, and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bergersen (United States Patent No. 5,203,695).

Bergersen discloses a generally horseshoe shaped clear flexible resilient plastic wire-imbedded orthodontic appliance for an upper arch or a lower arch of a patient, comprising: a plastic portion 10 with a lingual side, a labial side, a left molar area, a right molar area, a left canine area and a right canine area, including: contours on the lingual side and on the labial side, wherein the contours snugly cover the patient's teeth so that the appliance remains in place over the patient's teeth and so that the plastic portion guides the force of one or more flexible wires 50 imbedded within the lingual side of the plastic portion; and one or more flexible wires imbedded

within the lingual side of the plastic portion, extending from the left molar area to the right molar area of the plastic portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8, 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martz.

Martz discloses the invention essentially as claimed except for specifying that there are a first appliance, one or more intermediate appliances, and a final appliance (see col. 5, lines 4-14). The number of appliances provided, would have been an obvious matter of choice to one skilled in the art depending on the amount the teeth need to be moved and the number of steps required to move them. Regarding claim 5, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the cavities of each successive appliance differ by no more than 2 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

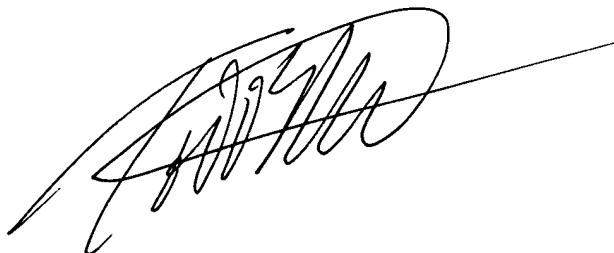
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
19 May 2005

A handwritten signature in black ink, appearing to read "TODD E. MANAHAN", is positioned to the right of the typed name and title.